REMARKS

The Office Action of December 1, 2003, has been reviewed, and in view of the following remarks, reconsideration and allowance of all of the claims pending in the application are respectfully requested.

Claims 5-9 are currently rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. More specifically, the Office Action alleges that claim 5 suffers from inferential claiming and there is no explicit antecedent basis in the claim for "the incentive matrix further comprises." Applicants request clarification for this rejection because claims 5-9 were canceled in the previous response to Office Action dated June 4, 2003. Further, the term "incentive matrix" does not appear in any of the pending claims. Further explanation and clarification are requested. It is believed that the rejection should be withdrawn.

According to one embodiment of the present invention, a system and method provide incentives to customers where the incentives are tailored to the customer's needs and expectations while achieving profitability to the provider. An embodiment of the present invention may determine a set of incentives based on call type, customer segmentation, as well as profitability factors. Upon receiving a request for termination or other request, the customer may be routed to an appropriate person, department, or group where the customer's account data may be identified and retrieved. The call type may be identified which describes the caller's present situation. Taking into consideration customer payment history and/or other past behavior, the customer may be categorized as a customer segment. Based on the call type, customer segment and profitability factors, a set of tailored incentives may be determined and

offered to the customer to promote customer loyalty and retention. If the customer does not accept the incentive, other sales opportunities may be offered to the customer in an effort to retain customer loyalty.

Claims 19-38 are presently rejected under 35 USC § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,009,415 to Shurling. The Office Action alleges that the entire document of Shurling makes obvious most of the claimed limitations. The Office Action recognizes that Shurling fails to show at least "where the account data is displayed on a graphical user interface" and "one or more profitability factors associated with a provider of the one or more incentives." For at least these deficiencies, the Office Action alleges that it would have been obvious to modify Shurling to include the admitted missing elements for "attracting and retaining long-term customers." Applicants respectfully disagree.

Shurling appears to be directed to a data processing technique for determining the number of different relationships that a customer has with the Bank (col. 1, lines 6-9). While Shurling makes mention of providing incentives, the incentives are based on a relationship score where the relationship score represents the number of *different relationships between a bank and each of its customers* (col. 1, lines 6-11). More specifically, the relationship score of Shurling is based on the number, type and duration of the relationships (col. 2, lines 54-56). Shurling recognizes that the incentive program for *attracting and retaining long-term customers* involves *monitoring the **relationships** between the bank and the customers* where opportunities are identified by evaluating relationships (col. 2, lines 34-41). Further, the incentive rewards are awarded to each customer based on the *automatically* determined relationship score (col. 2, lines 56-59). The incentives are ***not*** offered to the customer in response to a customer action (e.g.,

request to terminate a relationship with the provider). Shurling defines a loyal customer as "one who establishes all or a significant number of his relationships with a single bank and does so over an extended period of time" (col. 1, lines 30-34). Shurling rewards customers who have relationships with the Bank and who maintains those relationships for extended periods of time (col. 1, lines 57-60).

In particular, Shurling fails to consider *request type* identifying the customer's current situation, *customer segment* identifying the customer's past behavior, and *profitability factors associated with a provider* when determining incentives for retaining a customer. More specifically, Shurling fails to consider *customer request type* as the incentives appear to be automatically determined (col. 2, lines 56-59) and not in response to a customer request, as recited by the claims. Shurling also fails to consider at least *customer segment* and *profitability factors associated with a provider* when determining incentives. Rather, Shurling is concerned with monitoring a customer's relationships with a Bank, in particular, the number, type and duration of the relationships (col. 1, lines 6-11; col. 2, lines 34-41).

The Office Action alleges that the limitation of a graphical user interface is met by Shurling's FIG. 3 disclosure of a workstation computer combined with Shurling's mention of the term "graphical reports." However, there is no discussion in FIG. 3 or any other disclosure within Shurling that discusses the claim limitation of "retrieving account data associated with the customer in response to the request where the account data is displayed on the a graphical user interface." This claimed limitation is not shown anywhere in Shurling.

The Office Action alleges that the limitation of profitability factors is met by Shurling, where the Office Action relies upon "FIG. 5, the Abstract and the whole document." However,

the claim limitation of "identifying one or more incentives based on the request type, the customer segment and one or more profitability factors associated with a provider of the one or more incentives" is not disclosed anywhere in Shurling. This feature is completely missing from Shurling.

For most of the claim limitations, the Office Action relies continuously upon "the Abstract, FIG. 1, FIG. 2, FIG. 3, FIG. 4, FIG. 5, FIG. 6A, FIG. 6B, FIG. 6C, FIG. 7B, FIG. 8, FIG. 9, FIG. 10A, FIG. 10B, FIG. 11A, FIG. 11B, col. 1, lines 5-67; col. 2, lines 1-67; col. 3, lines 1-11; col. 6, lines 25-37; col. 8, lines 50-67; col. 15, lines 47-67; col. 16, lines 38-67; col. 17, lines 1-67; and col. 18, lines 1-15" and "the whole document."[1] Upon close examination of these highlighted section as well as the entire Shurling reference, it is clear that Shurling fails to show or make obvious the combination of claim limitations. The Examiner has failed to provide a basis of rejection for each and every claim limitation, as mandated by MPEP §§ 706.02(j) and 2143.03. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. The Examiner has clearly failed to reach the initial burden.

More specifically, Shurling fails to show, teach or suggest *receiving a request from a customer*; retrieving account data associated with the customer in response to the request where the account data is displayed on a graphical user interface; *identifying the request as a* ***request type****, where the request type identifies the customer's current situation*; *identifying the customer as a* ***customer segment****, where the customer segment identifies the customer's past behavior*;

[1] As Shurling lacks any disclosure that meets the claimed combination of limitations, the Office Action has chosen to rely on essentially the entire disclosure of Shurling, without any effort to identify specific teachings within Shurling that would meet each and every claim limitation.

identifying one or more incentives based on the request type, the customer segment and one or more profitability factors associated with a provider of the one or more incentives; and offering the customer at least one of the identified one or more incentives for retaining the customer *in response to the request*. System claim 29 recites similar limitations. The combination of claimed elements are simply not shown in Shurling. Of particular note is that the Examiner has repeatedly failed to point to an actual teaching in the reference, but rather relies on "the whole document." It is clear that each limitation alone and in the claimed combinations, as recited by independent claims 19 and 29, are not shown in Shurling.

While Applicants maintain that none of the combination of claimed limitations are shown by Shurling, the Office Action explicitly recognizes that Shurling fails to show at least "where the account data is displayed on a graphical user interface" and "one or more profitability factors associated with a provider of the one or more incentives."[2] For at least these deficiencies, the Office Action alleges that it would have been obvious to modify Shurling to include the admitted missing elements for "attracting and retaining long-term customers." Shurling recognizes an incentive program for *attracting and retaining long-term customers where Banks monitor the* ***relationships*** *between the bank and the customers* and where opportunities are identified by evaluating relationships (col. 2, lines 34-41). Thus, Shurling appears to teach that to attract and retain long-term customers, the relationships between the bank and the customer are to be monitored in determining the incentives where the relationship scores are based on number, type and duration of the relationships between the customer and the bank (col., 2, lines 34-41, lines 54-56). The teaching relied upon by the Office Action has absolutely nothing to do with the

[2] Applicants believe that additional limitations are not shown by Shurling as well.

admitted missing elements of Shurling. The basis for motivation is improper and the rejections should be withdrawn.

The Office Action has failed to set forth a *prima facie* case of obviousness for the independent claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's sole justification for modifying Shurling has absolutely nothing to do with the deficiencies of Shurling. As admitted by the Office Action, Shurling fails to show at least "where the account data is displayed on a graphical user interface" and "one or more profitability factors associated with a provider of the one or more incentives." To properly modify Shurling to correct for these major deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with Shurling. Any such motivation is completely lacking.

Accordingly, the Office has failed to provide any proper motivation for modifying Shurling, so the proposed modification fails. Even if Shurling could be modified as suggested by the Office Action, the resulting combination would nevertheless fail to show each and every limitation claimed by Applicants.

The mere fact that Shurling can be modified does not render the resultant modification

obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01*; see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Further, none of the cited references make up the deficiencies of Shurling. Dependent claims 20-28, 30-38 depend from either independent claims 19 and 29, respectively. As such, each of these dependent claims contain each of the features recited in the independent claims. For the reasons stated above, Shurling, alone or in any combination, fails to disclose the claimed inventions and the rejections should be withdrawn.

CONCLUSION

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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Date: February 12, 2004

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